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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,794	09/12/2003	Boris A. Miksic	2003-1969.ORI	8352
22476	7590	01/11/2005	EXAMINER	
HAUGEN LAW FIRM SUITE 1130 - TCF TOWER 121 SOUTH EIGHTH STREET MINNEAPOLIS, MN 55402			GREEN, ANTHONY J	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/661,794

**Applicant(s)**

MIKSIC ET AL.

**Examiner**

Anthony J. Green

**Art Unit**

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/15/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2 the phrase "is adapted to be dissolved in water" is confusing as written. What is meant by this phrase? How is the composition adapted to be dissolved in water? Clarification is requested.

In claim 4 the phrase "being adapted to be packaged" is confusing as written. What is meant by this phrase? How is the composition adapted to be packaged? Clarification is requested.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Miksic et al (US Patent No. 6,085,905).

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The reference teaches, in the General example found in column 2, a powder mix of VCI chemicals comprising 85-95 parts of ammonium benzoate, 2.5-7.5 parts of sodium benzoate, 2.5-7.5 parts of cyclohexylammonium benzoate, 2.5-7.5 parts of monoethanolammonium benzoate, 2.5-7.5 parts by weight of sodium sebacate, and 2-5 parts of benzotriazole. According to the claims the composition is packaged in a water soluble pouch.

The instant claims are met by the reference as the reference teaches a composition that encompasses that which is instantly claimed. Note that the amount of the components found in the instant claims are encompassed or overlap those taught by the reference. The feature of the composition being packaged in a water soluble bag is taught by the reference. With respect to instant claim 3 since each of the individual components taught by the reference are soluble in water it is believed that the corrosion inhibitor composition as a whole would also be soluble in water absent evidence showing otherwise.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miksic et al (US Patent No. 6,085,905).

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The reference was discussed in item #4 above.

The instant claim is obvious over the reference. While the reference does not teach that the composition is adapted to be dissolved in water in an amount necessary to form an aqueous solution having about 0.25 to about 5 percent by weight of said corrosion inhibitor composition it is the position of the examiner that this is a matter of obvious choice or routine optimization well known to one of ordinary skill in the art. One would find it obvious to prepare whatever concentration of solution is needed or desired depending on what the resulting composition is to be used for as the principles of dilution (i.e. the use of water to provide the desired composition) are well known to one of ordinary skill in the art and produces no unexpected results absent evidence showing otherwise. Based on the above reasoning the instant claim is seen to be obvious over the reference absent a showing otherwise.

#### ***Information Disclosure Statement***

7. The references have been considered however they are not seen to teach and/or fairly suggest the instant invention.

#### ***References Cited By The Examiner***


8. The remaining references are cited as showing the general state of the art and as such, they are not seen to teach or fairly suggest the instant invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anthony J. Green  
Primary Examiner  
Art Unit 1755

ajg  
December 27, 2004